

REMARKS

Claims 1 to 51 were originally filed and are subject to election. Claims 5, 6, 11, 12, 17, 18, 24, 25, 30, 31, and 36 are canceled herein without prejudice to their renewal. Claims 1-4, 7-10, 13-16, 19-23, 26-29, 32-35, and 37-51 are pending.

No new matter is added by any of the amendments.

I. Species Election

The Examiner stated that Applicants are required to elect a single disclosed species as follows:

1. A method for diagnosing a renal disorder as recited in claims 1-4, 7-12, 20-23, 26-35, 37-39, 42-44, and 47-49; or
2. A method of identifying a predisposition or susceptibility to a renal disorder as recited in claims 13-16, 19, 40-41, 45-46, and 50-51.

In view of the following remarks, Applicants respectfully request that the Examiner reconsider and withdraw the requirement for an election of species of methods as it relates to diagnosing a renal disorder or identifying a predisposition or susceptibility to a renal disorder.

The Examiner stated that the methods claimed in Group 1 and Group 2 are “distinct because they require different ingredients, method steps and endpoints” and, therefore, “...represent patentably distinct subject matter.” (See Election Requirement, page 3.) Applicants respectfully disagree. Applicants assume that by “ingredients” the Examiner is referring to materials and substances recited in the instant claims. If this is not correct, Applicants respectfully request notice and an opportunity to respond. The claims of Group 1 each involve detecting “CTGF protein” in “sample.” The claims of Group 2 each involve detecting “CTGF protein” in a “sample.” Therefore, the claims of Group 1 and Group 2 do not involve “different ingredients,” according to Applicants understanding of the term. Again, if the Examiner has a specific understanding of the term “ingredient” as used in the Examiner’s communication dated 05 September 2006, Applicants respectfully request an explanation and an opportunity to respond.

The Examiner further stated that the methods claimed in Group 1 differ from the methods claimed in Group 2 because “they require different ... method steps” (See Election Requirement, page 3.)

The claims of Group 1 each require the steps of “obtaining,” “detecting,” and “comparing.” The claims of Group 2 each require the steps of “obtaining,” “detecting,” and “comparing.” Therefore, the claims of Group 1 do not involve “different method steps” than the claims of Group 2.

Finally, the Examiner stated that the methods claimed in Group 1 are distinct from the methods claimed in Group 2 as the methods “require different ... endpoints.” (See Election Requirement, page 3.) Applicants respectfully request clarification as to the term “endpoint” as it is used here in reference to the pending claims. Applicants note that each claim in Group 1 and each claim in Group 2 recites a method that ends with a “comparing” step, wherein the level of CTGF protein in a sample is compared with a standard level of CTGF protein, and wherein a comparatively increased level of CTGF protein is indicative of the presence of a disease or disorder. These comparing steps recited in the claims of Group 1 are not different from, and are in fact the same as, the comparing steps recited in Group 2. Again, if the Examiner has a specific understanding of the term “endpoint” as this is used in the Examiner’s communication dated 05 September 2006, Applicants respectfully request an explanation and an opportunity to respond.

In summary, the Examiner requested that an election be made between the claims of Group 1 and the claims of Group 2 on the basis that the methods recited in these claims “require different ingredients, method steps and endpoints.” This is not correct. As described above, each of the pending claims requires the same “ingredients, method steps and endpoints.” Therefore, Applicants respectfully submit that the request for election is improperly applied to the present claims, and should be withdrawn.

Nonetheless, in order to comply with 35 U.S.C. 121, Applicants hereby elect, with traverse, methods for diagnosing a renal disorder as recited in claims 1-4, 7-12, 20-23, 26-35, 37-39, 42-44, and 47-49. Applicants acknowledge the Examiner’s confirmation that, upon the allowance of a generic claim, Applicants will be entitled to consideration of claims to additional species as provided by 37 C.F.R. 1.141. (See Restriction Requirement, page 3.) Applicants note the Examiner has not indicated which claims are generic. (See M.P.E.P. 809.02(a).)

Additionally, the Examiner stated that Applicants are required to elect a single disclosed species as follows:

1. a subject having:
 - Hyperglycemia as recited in claims 1-4, 7-10, 12-16, and 19;
 - Glomerular mechanical strain as recited in claims 20-23 and 26;
 - Hypertension as recited in claims 26-29;
 - Diabetes or diabetic nephropathy as recited in claims 32-35 and 37-41;
 - Glomerulosclerosis as recited in claims 42-46; or
 - Glomerulonephritis as recited in claims 47-51.

In view of the following remarks, Applicants respectfully request that the Examiner reconsider and withdraw the requirement for an election of species of a subject having hyperglycemia, glomerular mechanical strain, hypertension, diabetes or diabetic nephropathy, glomerulosclerosis, and glomerulonephritis.

The Examiner stated that these “species are distinct because the pathological conditions of each subject differ in etiologies and therapeutic endpoints; thus each condition represents patentably distinct subject matter.” (See Election Requirement, page 3.) Applicants respectfully submit that the etiologies and therapeutic endpoints of the pathological conditions of each subject are not recited limitations in the instant claims. Furthermore, as established in the present application, the etiologies of each of these conditions --- hyperglycemia, glomerular mechanical strain, hypertension, diabetes or diabetic nephropathy, glomerulosclerosis, and glomerulonephritis --- are typified by a common feature: an increased level of CTGF. Similarly, as established in the present application, the therapeutic endpoints of each of these conditions --- hyperglycemia, glomerular mechanical strain, hypertension, diabetes or diabetic nephropathy, glomerulosclerosis, and glomerulonephritis --- have in common a desired therapeutic effect: a decreased level of CTGF expression. Therefore, it is incorrect to state that the recited conditions “differ in etiologies and therapeutic endpoints.” Applicants submit that the requirement for election on this basis is thus improper and should be withdrawn.

Riser et al.

Response to Election Requirement mailed 05 September 2006

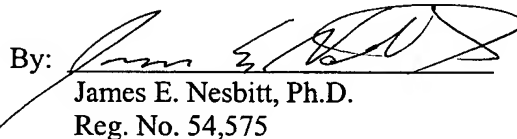
Nonetheless, in order to comply with 35 U.S.C. 121, Applicants elect, with traverse, a subject having hyperglycemia (claims 1-4, 7-10, 12-16, and 19). Applicants acknowledge the Examiner's confirmation that, upon the allowance of a generic claim, Applicants will be entitled to consideration of claims to additional species as provided by 37 C.F.R. 1.141. (See Election Requirement, page 3.) Applicants note that the Examiner has not indicated which claims are generic. (See M.P.E.P. 809.02(a).)

The Commissioner is hereby authorized to charge any necessary fees or credit any overpayment to **Deposit Account No. 50-0811, referencing Docket No. FP0806.1 CON US. A duplicate copy of this correspondence is enclosed for accounting purposes.**

Please call Applicants' representative at 650-866-7289 with any questions regarding the present communication or the above-referenced application.

Respectfully submitted,

Date: 05 March 2007

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